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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,737	08/10/2001	Fumio Tokutomi	212734US2	6661
22850	7590	03/17/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,737

Applicant(s)

TOKUTOMI ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 7-9, 11, 13, 15, 18, 20, 23, 26, 29, 32, 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/14/2005.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1,2,4-6,10,12,14,16,17,19,21,22,24,25,27,28,30,31 and 33.

DETAILED ACTION

1. Claims 1, 2, 4-6, 10, 12, 14, 16, 17, 19, 21, 22, 24, 25, 27, 28, 30, 31, 33

withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/27/2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 3, 7, 9, 11, 13, 15, 18, 20, 23, 29, 32, 34-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayward et al (US 6,798,997).

Regarding claim 3: Regarding claim 3, Hayward et al. (US 6 798 997) teach a print apparatus consumable purchase system (column 1, lines 8-16) comprising: a print apparatus (column 4, line 10 & fig 2, peripheral 10) for printing on a print medium, a display capable of displaying information concerning the print apparatus (fig. 3 & column 5, lines 24-39, display screen for print apparatus purchase system displays information concerning the peripheral 10); and a controller for displaying a status screen (figs 3 & 4, & column 5, lines 23-24 & 62-63, a display screen is used to display screen associated with the status of the peripheral 10) for representing consumption degree of a

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consumable used with the print apparatus on the display (fig 3 & column 5, lines 23-39, the display includes an "X" indicator to indicate a status condition in peripheral 10, wherein, column 5, lines 6-7, status conditions in peripheral 10 indicate a need for consumable replacement, which, column 8, lines 26-31, is based off of consumable level. In Specification, Applicant defines a consumption degree of a consumable as an "ink remaining amount." Therefore the indicator "X" taught by Hayward et al. and shown on the display in fig 3 represents an ink/toner remaining amount because it represents a low level) and displaying one (buy now, fig. 4) of a plurality of options (options to select buying from a preferred retailer, column 8, lines 60-65, options to buy now, options to have a diagnostics perform first before buying, column 7, lines 35-52, options to buy from a manufacturer, options to pay with a credit card, options for overnight express shipment, etc, column 8, lines 1-10) concerning the purchase mode (buying) of the consumable in the status screen (fig. 4), an option calling button (buy now button, column 8, lines 55-65) for calling the plurality of options concerning the purchase mode of the consumable in the status screen (column 8, lines 60-63).

NOTE: Although not specifically mentioned, a controller is inherently included in the system taught by Hayward et al. Without a controller, the functions associated with display of information as outlined above would not be available in the print apparatus consumable purchase system. Therefore the teachings of Hayward et al. inherently included a controller as outline above.

Regarding claim 7: Hayward teaches when the option calling button is selected, the controller connects to a predetermined server through a network and causes a

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screen to be presented, the screen displaying the plurality of options from the server and displays the screen on the display options from the server and displays the screen on the display (column 7, line 54 – column 8, line 12 and column 8:lines 54-63, when BUY NOW button is selected, a connection to server 40 is made, which provides a user screen with a plurality of purchase options: preferred distributor or not preferred distributor).

Regarding claim 9, Hayward et al. (US 6 798 997) teach the print apparatus consumable purchase system as claimed in claim 3, wherein the plurality of options concerning the purchase mode of the consumable are a plurality of options including a delivery purchase button for making a request for delivery purchase of the consumable and a store purchase button for calling dealer information concerning a dealer dealing in the consumable (column 7, line 54 -column 8, line 12, the BUY NOW button provides both the request for delivery purchase of the consumable, and, column 8, lines 54-63, the called dealer information concerning a dealer, i.e. a retailer, that can be accessed by the user, who is prompted to confirm a dealer choice).

Regarding claim 11, Hayward et al. (US 6 798 997) teach the print apparatus consumable purchase system as claimed in claim 9, wherein if the delivery purchase button is selected, the controller acquires an ordering screen for ordering the consumable from a predetermined server through a network and displays the screen on the display (column 7, line 54 - column 8, line 12, a purchase order screen is acquired from a predetermined server 40 and displayed to the user).

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Regarding claim 13, Hayward et al. (US 6 798 997) teach the print apparatus consumable purchase system as claimed in claim 11, wherein if the delivery purchase button is selected, the controller acquires a screen to be presented, the screen containing one of a selling condition input field for entering selling condition information (column 7, line 66 - column 8, line 2, the user enters the selling conditions) and a selling condition disclosure field for disclosing selling condition information (column 8, lines 9-11, selling conditions are disclosed on the screen) as the ordering screen from a predetermined server through a network and displays the screen on the display.

Regarding claim 15, Hayward et al. (US 6 798 997) teach the print apparatus consumable purchase system as claimed in claim 13, wherein at least one of in-stock and out-of-stock concerning the consumable and availability of empty vessel collection service is disclosed in the selling condition disclosure field (column 8, lines 9-10, a confirmation display is sent to the user's display after, column 8, lines 49-53, confirming availability of inventory, which provides the in-stock disclosure).

Regarding claims 18, 20: Hayward et al. (US 6 798 997) teach the print apparatus consumable purchase system as claimed in claim 11, wherein if the delivery purchase button is selected (fig 4 & column 7, line 54, BUY NOW button), the controller acquires a screen containing a retrieval key information input field for entering user's place retrieval key information as an ordering screen for ordering the consumable from a predetermined server through a network and displays the screen on the display (column 7, line 54 - column 8, line 25, user information concerning user location address is input in ordering screen that has been downloaded from predetermined

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server 40 after selecting the BUY NOW button), and the controller transmits the user's place retrieval key information entered in the retrieval key information input field to the server (column 8, lines 48-49, server receives user information) so as to receive place-dependent selling condition information extracted by the server based on the user's place retrieval key information (column 8, lines 46-54, based on user information, server 40 processes the order by shipping directly to the user or forwarding the order for local delivery from a retailer local to the user. In the teachings of Hayward et al. the place-dependent selling condition is delivery method that is based on user location and that changes depending on the location of the shipper in relation to the user. Along with delivery method, a confirmation differs based on user location relative to local distributors) and displays the received place-dependent selling condition information on the display (column 7, line 67 - column 8, line 12, purchase order confirmation is displayed, which would indicate confirmation of delivery method acceptance information).

Regarding claim 23, Hayward et al. (US 6 798 997) teach the print apparatus consumable purchase system as claimed in claim 11, wherein if the store purchase button is selected, the controller causes a screen to be presented for providing the dealer information from a predetermined server through a network and displays the screen on the display (column 7, line 54 - column 8, line 12 & column 8, lines 54-63, BUY NOW button, i.e. store purchase button, is selected and a display that provides dealer information is provided from a server 40 and for the user).

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Regarding claims 29, 32, 34: Hayward et al. (US 6 798 997) teach print apparatus consumable purchase system as claimed in claim 11, wherein if the store purchase button is selected (fig. 4 & column 7, line 54, BUY NOW button), the controller acquires a screen containing a retrieval key information input field for entering user's place retrieval key information (column 8:lines 48- 49, server receives user information that has been input by user and displays the screen on the display (column 7, lines 60- 65, purchase order screen is provided to user)), and the controller transmits the user's place retrieval key information entered in the retrieval key information input field to the server (column 8, lines 48-49, server receives user information that has been input by user) so as to receive place-dependent dealer information extracted by the server based on the user's place retrieval key information (column 8, lines 46-54, based on user information, server 40 processes the order by shipping directly to the user or forwarding the order for local delivery from a retailer local to the user. In the teachings of Hayward et al. the place-dependent selling condition is delivery method that is based on user location and that changes depending on the location of the shipper in relation to the user. Along with the delivery method, a confirmation differs based on user location relative to local distributors) and displays the received place-dependent dealer information on the display (column 7, line 67 - column 8, line 12, purchase order confirmation is displayed, which would indicate confirmation of delivery method acceptance information).

Regarding claim 35, Hayward et al. teaches, wherein the consumable is a coloring material cartridge (fig 4, magenta ink level indicates that the consumable is a coloring material cartridge. Also see column 9, lines 40-42).

Regarding claims 36, 38: Hayward et al. (US 6 798 997) teach a program stored in a computer readable medium (inherent) for causing a computer to function as control means (column 4, lines 10-20, the program is installed on computer to interact with printer consumable purchasing system shown in fig 2).

Regarding claim 37, Hayward et al. teaches, wherein the consumable is a coloring material cartridge (fig 4, magenta ink level indicates that the consumable is a coloring material cartridge. Also see column 9, lines 40-42).

Claim Rejections - 35 USC § 103

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward (US 6,798,997).

Regarding claim 8, Hayward et al. (US 6 798 997) teach the print apparatus consumable purchase system as claimed in claim 3, wherein when the option calling button is selected (column 7, line 54 – column 8, line 12 and column 8:lines 54-63, when BUY NOW button is selected, a connection to server 40 is made, which provides a user screen with a plurality of purchase options: preferred distributor or not preferred distributor), the controller displays the plurality of options on the display (column 8, lines 60-65) and if any option is selected from among the plurality of options, the controller

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connects to a predetermined server through a network and acquires a order screen to be present (column 8, lines 1-15).

Although Hayward does not mention the presented screen is corresponded to the selected option from the server, it would have been obvious to a person with ordinary skill in the art the order screen that allows user to order the parts must correspond to the user selection of whether the user want to order from the preferred retailer.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward as applied to claim 23 above, and further in view of Benjamin et al (US 6,113,208).

Regarding claim 26, Hayward et al. teach the print apparatus consumable purchase system as claimed in claim 23, but do not teach wherein the dealer information contains at least one of address information and map information for locating a dealer place.

However, Benjamin et al. teach dealer information containing an address displayed to the user (column 3, lines 42-45).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have use the address information taught by Benjamin et al. in the provision of dealer information taught by Hayward et al. because it allows the user to locate suppliers nearby for more ordering flexibility.

Response to Arguments

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6. Applicant's arguments filed 9/7/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that Hayward is not a valid reference under 35 USC 102 (e) has been considered.

In reply: MPEP 201.11 and USC 120 states that "An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and it contains or is amended to contain a specific reference to the earlier filed applications..."

Column 1, lines 1-5, Hayward clearly states that "This application is a continuation-in-part of U.S. application Ser. No. 09/397,126 filed Sep. 16,1999, the disclosure of which is totally incorporated by reference."

The examiner has carefully compared the disclosure of 09/397,126 and US 6,798,997 and the fact presented is that the information relied upon in US 6,798,997 is disclosed by 09/397,126. US 6,798,997 is filed before the patenting or abandonment of or termination of proceedings on application 09/397,126.

Therefore, the effective filing date of Hayward et al (US 6,798,997) is 9/16/1999.

MPEP 2136.02 states that: "When a U.S. patent, a U.S. patent application publication, or an international application publication is used to reject claims under 35 USC 102 (e), the disclosure relied on in the rejection must be presented in the issued patent or application publication. It is the earliest effective US filing date of the US patent or application publication being relied on as the critical reference date..."

Therefore, Hayward is a valid reference under 35 USC 102(e).

With respect to applicant's argument on page 16, lines 11-14 that Hayward teaches at least a single purchase option "Buy Now" but Hayward does not teach a button for reserving an item for pick up; has been considered.

In reply: The examiner concurs with the applicant's founding that the "buy now" option is a purchase option. The limitation of "a button for reserving an item for pick up" is not part of the claimed limitation of claim 3.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 7, 2006



**KING Y. POON
PRIMARY EXAMINER**